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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/016,707 01/30/98 MEYER

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EXAMINER

XU, H

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

09/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/016,707

Applicant(s)

Mayer

Examiner

Hong J. Xu

Group Art Unit

1774

☒ Responsive to communication(s) filed on Jan 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-50 is/are pending in the application.

Of the above, claim(s) 9-50 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of claims 1-8 in Paper No. 7 is acknowledged.  
Claims 9-50 are withdrawn from consideration.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "said coal slag particles" in line 1. There is insufficient antecedent basis for this limitation in the claim. Also, it is not clear what the weight percentage is based on. For the purpose of this examination, it is presumed to be based on total weight of particles.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hnat et al.

Hnat et al, in describing current problems of mineral wool processing, discloses that the coal slag mixture is melted in a coke-fired cupola. The mixture is heated to 2600-2850 °F. During the subsequent physical fiberizing process, up to 50% of the molten material forms small spheres less than 300 microns in diameter and is removed as a waste (Page 74-3, last paragraph).

The current applicant uses essentially the same starting material: coal slag, and subject this material to a comparable temperature as in Hnat et al (Page 9, line 1). The claimed size of the resulting particles are also comparable to that in Hnat. Therefore, it is inherent that the "waste" in Hnat is a similar article as claimed in claims 1-4, and 6-8.

Although Hnat et al did not teach the use of its waste product, the existence of such a product renders the claims of the current applicant unpatentable.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hnat et al, further in view of Toussaint.

As discussed above, Hnat et al discloses an article similar to that claims in this application. However, Hnat et al did not teach the coating on this article since Hnat et al regard it as a "waste."

Toussaint teaches the use of vitreous bead as fillers for plastics material, or as fillers for certain explosives, especially those based on aqueous emulsion, or incorporated in paint (Page 1, line 5-15).

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to coat such particles to fit them into proper use. For instance, if the particles are to be incorporated in paint, it would naturally be coated with a pigment.


### *Conclusion*


8. Should you have any questions concerning this communication, please direct them to Hong J. Xu at 703-305-1035. The examiner can be reached at this number from 8:00 am to 4:30 pm E.S.T. Monday -Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, William Krynski, can be reached at 703-308-2376. Please allow the examiner twenty-four hours to return your call.

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A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1700 are 703-305-3599 for official after-final faxes, and 703-305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-2351.

  
William Kynski  
Supervisory Patent Examiner  
Technology Center 1700

hjk 

September 14, 1999